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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/612,696 07/10/00 WOOD

A 91-62.20

022823 MM91/1005  
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EXAMINER

KARLSEN, E

ART UNIT

PAPER NUMBER

2858

DATE MAILED:

10/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No. 09/612696	Applicant(s) WOOD ET AL
Examiner E. KARLSEN	Group Art Unit 2858

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 7-10-00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 34-54 is/are pending in the application.
- Of the above claim(s) 42 and 47-54 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 34-41 and 43-46 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3 (3 sheets)
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 34-46, drawn to a test fixture, classified in class 324, subclass 755.
  - II. Claims 47-54, drawn to a method for testing, classified in class 324, subclass 755.
2. The inventions are distinct, each from the other because:
3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case the fixture could be used as a functional device without any testing.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. With the election of one of the above groups further election of species is required as follows:
6. This application contains claims directed to the following patentably distinct species of the claimed invention:
  1. The species of Figures 1-3.
  2. The species of Figure 4.
  3. The species of Figure 5.
  4. The species of Figure 6.
  5. The species of Figure 7

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6. The species of Figure 8

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim appears to be generic.

7. With the election of one of the above species further election of subspecies is required as follows: (Read "species" as "subspecies").

8. This application contains claims directed to the following patentably distinct species of the claimed invention: 1. The subspecies where the bump is metal.

2. The subspecies where the bump is a conductive polymer.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CAR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MEP. § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. During a telephone conversation with Mr. Stephen a. Gratton on September 19, 2001 a provisional election was made with traverse to prosecute the invention of Group I, the species of figure 8 and the subspecies where the bump is metal, claims 34-41 and 43-46. Affirmation of this election must be made by applicant in replying to this Office action. Claims 42 and 47-54 are withdrawn from further consideration by the examiner, 37 CAR 1.142(b), as being drawn to a non-elected invention.

10. Claims 34-41 and 43-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The only portion of the specification that relates to the embodiment of Figure 8 is the last 6 lines on page 11 of the specification. No mention of a first plate, a second plate, plastic film, test circuitry, conductive trace, bumps, electrical connector trace, direct electrical path, polyamide, plastic film, die receiving cavity, elastomeric biasing member, compressible elastomeric pad, solder, a connector providing an electrical path independent of the first plate and the second plate, metal, a cavity for retaining the die or the first

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plate includes a cavity and a spacer member within the cavity is present in the last 6 lines of page 11 of the specification and all of the listed terms are considered to be without basis in the specification.

11. Claims 34-41 and 43-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The only portion of the specification that relates to the embodiment of figure 8 is the last 6 lines on page 11 of the specification. It is not clear what the parts of figure 8 are or how they are assembled.

12. Claims 34-41 and 43-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what all the claimed elements are and it is not clear how they are interconnected and interrelated to produce the desired results.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

14. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 34-41 and 43-46 are insofar as understood, rejected under 35 U.S.C. 102(b) as being fully anticipated by any one of Kattner et al, Enochs, Jamison et al, Greub et al, Littlebury et

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al, Malhi et al, Elder et al '850 or Item 32636 of the Research Disclosure No. 326 cited by applicants as Item U.

Test of wafers, die and multichip hybrids are considered equivalent. For support of the above statement see Elder et al '850. Note also that Enochs uses polyamide film. That which is tested by Jamison et al is considered equivalent to a die.

16. All applied references except for Kattner et al were cited by applicants.

Karlsen/Tr

9/28/01

  
ERNEST KARLSEN  
PRIMARY EXAMINER